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EXAMINER

CINTINS, I

13M1/0921

ART UNIT

PAPER NUMBER

9

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1308

DATE MAILED:

09/21/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s) _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-24 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-24 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

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Claims 10, 16, 17 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "selected from" (claim 10) is deemed to be improper Markush language, and therefore indefinite. Applicant is advised that an amendment inserting "the group consisting of" after "from" in the above noted expression would overcome this portion of the rejection. Also, the terms "for the filtration or removal of ..." (claim 16), "for the retention of ..." (claim 17) and "use as ..." (claim 19) are vague, and indefinite as to the manipulative steps of the recited processes.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7, 9-13, 16, 18 and 19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Teng et al. (U.S. Patent No. 3,788,984, hereinafter "Teng '984").

Claims 1, 2, 9, 11-13, 15, 16, 18, 19, 22 and 23 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Teng et al. (U.S. Patent No. 3,915,855, hereinafter "Teng '855").

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 3, 4, 8 and 22-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '984. The reference discloses the claimed invention with the exception of the weight gain of the treated material (claims 3 and 4), the type of lignocellulosic material employed (claim 8), and the physical form (i.e. sheet) of this material (claims 22-24). However, the exact weight gain of the reference material after treatment, its type and physical form are not seen to be result effective variables, and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 3, 4 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '855. The reference discloses the claimed invention with the exception of the weight gain of the treated material (claims 3 and 4) and the type of oil (i.e. transformer) removed (claim 17). However, the exact weight gain of the reference material after treatment, and the type of oil removed are not seen to be result effective variables, and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 14, 20 and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '984 in view of Fahlvik. The primary reference discloses the claimed invention with

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the exception of the outer covering for the modified plant material. Fahlvik discloses encasing a cellulosic oil absorbent material in a mesh covering. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified plant material of the primary reference with the covering of the secondary reference, in order to facilitate handling of this primary reference material.

This application does not contain an Abstract of the Disclosure as required by 37 C.F.R. § 1.72(b). An Abstract on a separate sheet is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for this Group is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1308

I. Cintins
September 14, 1994